IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1917.

No. .

MATTHEW T. CHAPMAN and MARK C. CHAPMAN,
Petitioners,

vs.

JOHN A. WINTROATH.

PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA, AND BRIEF IN SUPPORT THEREOF.

To the Honorable, The Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, Matthew T. Chapman and Mark C. Chapman, respectfully pray for a writ of certiorari to review the judgment of the Court of Appeals of the District of Columbia in the above-entitled cause.

Questions Presented.

The questions presented are:

1. Where an applicant for patent has filed and prosecuted his application strictly according to the provisions of the Statutes and the Rules of the Patent Office, can he lawfully be refused a patent on the sole ground that he did not introduce certain specific claims into his application within one year after the issuance, without notice to him, of a patent containing such claims to a *later* inventor and *later* applicant?

2. On an interference appeal from the Patent Office under the Act of February 9, 1893 (27 Stat. L., 434, Ch. 74), is the jurisdiction of the Court of Appeals of the District of Columbia confined to a determination of the question of priority of invention, and may the question of whether a statutory bar exists to the grant of a patent to the actual first inventor of the subject-matter of the issue be determined on such appeal?

Brief Statement of the Case.

The judgment of the Court of Appeals of the District of Columbia sought to be reviewed was rendered on an interference appeal taken by the respondent, Wintroath, from the decision of the Commissioner of Patents, which awarded priority of invention as to the subject matter of the issue to the petitioners, Chapman and Chapman. The Court of Appeals reversed the decision of the Commissioner and awarded priority to Wintroath on the sole ground that because Chapman and Chapman did not introduce into their application the precise claims of the issue of the interference within one year from the date of the grant of Wintroath's patent containing such claims they were estopped to make

them at all, under the authority of the recent decision of the same court in *Rowntree* v. *Sloan*, 227 O. G., 744; 45 App. D. C., 207. The decisions of the lower tribunals of the Patent Office followed the ruling of the Rowntree-Sloan case, but the Commissioner held that the doctrine therein announced was inconsistent with the statutes and declined to apply it.

Chapman and Chapman were the first to file an application fully showing and describing the invention in controversy, and Wintroath's patent was applied for and issued while Chapman and Chapman's original application was pending and without notice to them. Later, and while their original application was still pending in the Patent Office, Chapman and Chapman, as required by the Examiner, filed a divisional application for certain subject-matter, including the invention in controversy, which was withdrawn for that purpose from their original application. The precise claims of the interference issue were made in such divisional application about one year and eight months after Wintroath's patent was issued.

It is not controverted that Chapman and Chapman were the *actual* first inventors of the issue, as Wintroath's sworn date of conception thereof was more than a year and six months later than Chapman and Chapman's filing date. That Chapman and Chapman's original and divisional applications were filed and prosecuted according to the provisions of the Statutes and the Rules of Practice, and were never abandoned or forfeited, is also not disputed. The judgment of the Court of Appeals awarding priority to Wintroath—notwithstanding his own admission that he was not the actual first inventor of the subject-matter of the interference—on the sole ground that Chapman and Chapman were estopped from claiming such invention be-

cause they did not make certain specific claims therefor within one year after Wintroath's patent was issued, is, therefore, a judicial finding establishing as the law of the Patent Office the affirmative of Question 1 presented by this petition.

As the effect of the ruling of the Court of Appeals is that Chapman and Chapman, admittedly the first inventors thereof, abandoned the invention in controversy by failing to make certain claims within a limited time, the decision sought to be reviewed is necessarily predicated upon the right of the Court of Appeals to consider and determine on an interference appeal the question of a statutory bar to the grant of a patent to one of the parties—notwithstanding the ruling by this court that the Court of Appeals is without jurisdiction so to do. (*Lowry* v. *Allen*, 203 U. S., 476.) This point is raised by Question 2 presented by this petition.

Reasons of Public Import for the Issuance of the Writ.

This case is of great importance for the following reasons:

The decision of the Court of Appeals on the point raised by Question 1, presented by this petition, overturns the practice of the Patent Office as it has existed for more than forty years, and establishes a new rule inconsistent with the Statutes, which applies generally to all applicants for patents.

Said decision is obnoxious to and defeats the long-established policy of the Patent Laws to reward the inventor who was the first to conceive and perfect his invention and to disclose it to the public.

It bars the Patent Office in certain cases from proceeding under Section 4904 Rev. Stat, to ascertain who, as

between rival claimants, is, in fact, the prior inventor.

It denies to applicants rights specifically given them by the Statutes of the United States.

It is unconstitutional because it is an assumption by the Court of Appeals of legislative powers and the right to enact laws in derogation of the laws of Congress. (See *Boston Store* v. *Am. Graphophone Co. et al.*, 249 O. G., 985, p. 988.)

It is directly in conflict with the decision of this court in the case of *U. S.* v. *American Bell Telephone Co. et al.*, 167 U. S., 224.

It is retroactive and divests applicants of rights possessed by them under the Statutes and Rules of Practice of the Patent Office at the time their applications were filed.

It is inconsistent with the established Patent Law of the country as defined by this court and by the several Circuit Courts of Appeals.

As regards the point raised by Question 2 presented by this petition, the decision of the Court of Appeals is directly in conflict with the decision of this court in the case of *Lowry* v. *Allen*, 203 U. S., 476, which specifically holds that on interference appeals the Court of Appeals of the District of Columbia has jurisdiction to consider only the question of priority of invention, and is without jurisdiction to consider the question of the existence of a statutory bar to the grant of a patent to one of the parties.

It is also directly in conflict with many of its own late decisions, all of which deny the jurisdiction of the Court of Appeals to consider the question of a statutory bar on interference appeals.

Other Reasons.

The action of the Court of Appeals in decreeing priority to Wintroath notwithstanding the indisputable fact that he conceived the invention long after Chapman and Chapman filed their original application for patent fully disclosing such invention, which application was regularly prosecuted according to law and the Rules of the Patent Office, and was never abandoned or forfeited, has no justification in law, is a dangerous assumption of arbitrary power by the court, is a deliberate disregard of the authority of this court (see *U. S.* v. *Am. Bell Tel Co.*, 167 U. S., 224), and is clearly a denial of justice.

Chapman and Chapman having completed the invention and filed their application for patent therefor before Wintroath's conception thereof, the action of the Court of Appeals in assuming jurisdiction in this case to consider and decide the question of a statutory bar to the grant of a patent to Chapman and Chapman was erroneous and in direct conflict with the ruling of this court in *Lowry* v. *Allen*, 203 U. S., 476.

In view of the undisputed fact that Chapman and Chapman were the first inventors of the subject-matter of the issue, the judgment of the Court of Appeals awarding priority of invention to Wintroath was erroneous and should be reversed.

For these reasons it is submitted that a writ of certiorari should issue and the questions involved be determined by this court.

JOHN L. JACKSON,
ALBERT H. ADAMS,
Counsel for Petitioners.

BRIEF IN SUPPORT OF PETITION.

Statement of the Facts.

There is no controversy as to the facts, which are as follows:

On March 10, 1909, the petitioners, Chapman and Chapman, filed their application, Serial No. 482,517, for letters patent for certain improvements in Deep Well Pumps, which application was regularly prosecuted according to the Statutes and the Rules of the Patent Office until it matured into letters patent No. 1,149,633, dated August 10, 1915.

On July 6, 1915, the petitioners filed their application for patent, Serial No. 38,254, as a division of their said application No. 482,517, *then still pending,* describing and claiming in such divisional application certain subject-matter fully shown and described in said parent application No. 482,517, such divisional application being filed in accordance with the Statutes and the Rules of Practice of the Patent Office. Under the settled practice as it has been established for many years, said divisional application related back to and was entitled to the date of said parent application.

On December 2, 1912, the respondent, John A. Wintroath, filed his application for patent, Serial No. 734,649, showing and describing certain subject-matter shown and described in the petitioners' said original application, and also shown and described in petitioners' said divisional application. Said Wintroath application was regularly prosecuted without notice to petitioners, and on November 25, 1913, matured into letters patent No. 1,079,679.

On March 21, 1916, an interference was declared in the Patent Office between your petitioners and said Win-

troath, the subject-matter of said interference being defined in claims 2, 3 and 4 of said Wintroath patent, and claims 1, 2 and 3 of the petitioners' application. It is unnecessary to consider in detail the claims which constitute the subject-matter of the interference as it will suffice for the purpose of this petition to say that the invention is the combination with the power shaft of a deep-well pumping mechanism, of a fluid-operated bearing which supports said shaft, and an auxiliary bearing for sustaining resultant downward thrust of the power shaft. The Chapman and Chapman original application, as filed, illustrated and described said subject-matter, and contained claims for each of the bearings combined with the power shaft, but it contained no claims for the combination of both bearings with the power shaft, and claims for such specific combination were not made by them until they filed their divisional application on July 6, 1915.

The usual preliminary statements were required to be filed on or before May 1, 1916, and were duly filed by both parties.

In his preliminary statement Wintroath declared that he conceived the invention contained in the claims of his said patent on or about the first day of October, 1910, which was more than one year and six months *after* Chapman and Chapman's original application fully showing and describing said invention was filed in the Patent Office. In view of the fact that Wintroath's date of conception of the invention was later than Chapman and Chapman's filing date their preliminary statement was not opened for publication, and they have been given no opportunity to prove the facts therein set forth.

On May 5, 1916, in accordance with Rule 114* of the

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* See foot note p. 12.

Patent Office, the Examiner of Interferences served notice on Wintroath that judgment on the record would be entered against him unless he should, within 30 days, show sufficient cause why such action should not be taken.

On June 21, 1916, after having filed certain motions which are not material to this petition, Wintroath moved for judgment on the record in his favor on the ground that Chapman and Chapman were estopped from making the claims of the issue, that the facts which raise the estoppel also work an abandonment, and that to award the claims to Chapman and Chapman would, under the facts, be against public policy.

This motion was based entirely upon the then just published decision of the Court of Appeals of the District of Columbia in the case of *Rowntree* v. *Sloan* (227 O. G., 744; 45 App. D. C., 207), in which it was held that "*Sloan's laches, in failing within a reasonable time after the issuance of the Rowntree patent to make these claims, estopped him to make them at all. . . . If he thought these claims read upon his application, it was his duty promptly to make them, at least within the time allowed for amendment after Office action* (one year), *and his failure to do so is fatal to his present contention.*"

The Examiner of Interferences, in deciding Wintroath's motion for judgment in his favor, held that the doctrine of *Rowntree* v. *Sloan* applied, and awarded priority to Wintroath *notwithstanding the fact that the records of the Patent Office showed that he was not the first inventor of the subject-matter of the interference.*

Chapman and Chapman accordingly appealed to the Board of Examiners-in-Chief, who affirmed the decision of the Examiner of Interferences on the ground that they were bound by the decision of the Court of Appeals in the Rowntree-Sloan case, and did not feel that they were

authorized to set aside the practice instituted by that decision.

Chapman and Chapman thereupon appealed to the Commissioner of Patents, who reversed the decision of the Board of Examiners-in-Chief and the decision of the Examiner of Interferences, and awarded priority of invention to Chapman and Chapman. In deciding the case the Commissioner said (Record, p. 84):

> "To establish a fixed limit of one year after which claims may not be copied from a patent presents two serious difficulties.
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> "In the first place, an applicant who has waited more than one year to amend his application may save his rights by showing to the Commissioner that the delay was unavoidable (Revised Statutes, Section 4894). Moreover, generally speaking, laches is a charge which is rebuttable unless the delay exceeds a period specified by statute. No matter what period be taken it seems clear, therefore, that the right to explain the delay must be granted to the applicant.
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> "In the second place, an inventor after another has patented the invention may wait up to two years before filing his own application therefor (Revised Statutes, Section 4886). Since the making of a claim is a mere incident to the patenting of an invention, a patent could not be denied on any theory of laches in such a case.
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> "No reason is seen why a stricter rule should be laid down to regulate the conduct of an inventor who has already filed his application at the time when a rival patent is granted than would be applied to one who filed after the rival patent was granted.
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> "In the Rowntree-Sloan case the question whether the limit of time should be set at one year or two years was not directly involved and therefore presumably was not considered as fully as it would have been had it been necessary for the disposition of the case.
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> "I am persuaded that on further consideration the Court of Appeals instead of selecting the time

allowed for amendment by Section 4894 will follow Section 4886, making the time two years.

"The limit of two years would also be supported by analogy with the treatment of reissue cases in *Miller* v. *Brass Company,* 104 U. S. 350, *Mahn* v. *Harwood,* 112 U. S. 354, and *Wollensak* v. *Reiher,* 115 U. S. 101. There is, however, this difference that whereas the rule in reissue cases demands diligence at all times with especially good explanation if the delay exceeds two years, the diligence of one who, having already filed, copies its claims within two years of the granting of a patent, cannot be inquired into without imposing a condition more strict than is imposed by Section 4886 upon one who does not file his application until after the rival patent has been granted."

Wintroath thereupon appealed to the Court of Appeals of the District of Columbia, which court held that because Chapman and Chapman did not make the precise claims of the interference issue until about one year and eight months after the issuance of the Wintroath patent, they were estopped from making them at all, and that, therefore, Wintroath was entitled to judgment of priority of invention notwithstanding the fact that he did not conceive such invention until more than a year and a half after Chapman and Chapman had filed in the Patent Office an application fully illustrating and describing such invention. The court definitely announced its adherence to the doctrine of the Rowntree-Sloan case with the modification, however, that the period should be one year unless the applicant should satisfy the Commissioner that the delay was unavoidable, but gave Chapman and Chapman no opportunity to present such a showing.

Judgment was entered accordingly on March 4, 1918.

On March 16, 1918, Chapman and Chapman filed their petition for rehearing, which petition was, on the 23rd day of March, 1918, denied.

The present petition is brought to review the aforesaid judgment of the Court of Appeals of the District of Columbia with respect to the propositions of law upon which it was founded.

Statutes Involved.*

Sec. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than *two years prior to his application*, and not in public use or on sale in this country for more than two years prior to his application, unless the same

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* Patent Office Rules Involved.

Rule 68. The applicant has a right to amend before or after the first rejection or action; and he may amend as often as the examiner presents new references or reasons for rejection. . . .

Rule 77. If an applicant neglect to prosecute his application for one year after the date when the last official notice of any action by the office was mailed to him, the application will be held to be abandoned, as set forth in Rule 171. . . .

Rule 93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

Rule 94. Interferences will be declared in the following cases, when all the parties claim substantially the same patentable invention; . . .

(2) Between an original application and an unexpired patent containing conflicting claims, when the applicant, having been rejected on the patent, shall file an affidavit that he made the invention before the patentee's application was filed. . . .

Rule 114. If the junior party to an interference, or if any party thereto other than the senior party, fails to file a statement, or if his statement fails to overcome the *prima facie* case made by the respective dates of

is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

Sec. 4887. . . . But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than *two years* before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing.

Sec. 4894. All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be

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application, such party will be notified by the examiner of interferences that judgment upon the record will be rendered against him at the expiration of thirty days, unless cause is shown why such action should not be taken.

Rule 116. In original proceedings in cases of interference the several parties will be presumed to have made the invention in the chronological order in which they filed their completed applications for patents clearly illustrating and describing the invention; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

Rule 171. An abandoned application is one in which all the essential parts have not been filed so that it is completed and prepared for examination within a period of one year, or which the applicant has failed to prosecute within one year after any action therein of which notice has been duly given (see Rules 31 and 77), or which the applicant has expressly abandoned by filing in the office a written declaration of abandonment, signed by himself and assignee, if any, identifying his application by title of invention, serial number, and date of filing. (See Rule 60.)

Prosecution of an application to save it from abandonment must include such proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment under section 4894 of the Revised Statutes.

shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

Sec. 4903. Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case.

Sec. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any *unexpired* patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

ACT OF FEB. 9, 1893, CH. 74; 27 STAT. L., 434.

Sec. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be, and the same is hereby, vested in the court of appeals created by this act;

and in addition any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said court of appeals.

First Question.

Where an applicant for patent has filed and prosecuted his application strictly according to the provisions of the Statutes and the Rules of the Patent Office, can he lawfully be refused a patent on the sole ground that he did not introduce certain specific claims into his application within one year after the issuance, without notice to him, of a patent containing such claims to a later inventor and later applicant?

Under Section 4886, Rev. Stat., an issued patent is not a bar to the grant of a patent for the same invention to a *later* applicant unless the later application was filed more than *two* years after the grant of the patent, and under no circumstances does the Statute make the issuance of a patent to one inventor a bar to the grant of a patent for the same invention to an *earlier* applicant who is duly prosecuting his application. On the contrary, Section 4904, Rev. Stat., specifically makes provision for the determination of the question of priority as between the patentee of any unexpired patent and an applicant having a pending application in the Patent Office.

It follows, therefore, that an applicant, whose pending application for patent was filed in the Patent Office less than two years after the grant of a patent to another for the same invention, has an absolute right to have the question of priority determined as between him and the prior patentee, and if the applicant should prove to be the first inventor, he is entitled under the Statutes to the grant of a patent to him for such invention. Obvi-

ously this rule applies whether the applicant's application was filed earlier or later than the patentee's application.

This practice has been consistently followed by the Patent Office for more than forty years, and until the decision of the Court of Appeals of the District of Columbia in the case of *Rowntree* v. *Sloan,* its legality was unquestioned. (See *Rolfe* v. *Hoffman,* 26 App. D. C., 336, p. 340.) The Rowntree-Sloan decision, however, announced the novel doctrine that unless an applicant introduced into his application claims corresponding with those of an issued patent within *one* year from the grant of such patent, he was estopped from making such claims at all, thereby making the failure of an applicant to make claims corresponding to those of a patent within *one* year from the grant thereof operate as an abandonment by him to the patentee of the invention defined by such claims.

Not only is this doctrine entirely without foundation in law, but it is absolutely inconsistent with Section 4886, Rev. Stat. For example, under Section 4886, an inventor may put his invention into public use for any period less than two years, and may then file his application for and receive a valid patent for his invention, notwithstanding anything that may have been done by later inventors in the meantime. After the first inventor has put his invention into public use, and before he has filed his application for patent, a later inventor may apply for and receive his patent, and it is quite possible, and occasionally happens, that such later inventor may receive his patent more than a year before the first inventor makes his application, but, under Section 4886, the issuance of such patent to a later inventor in no way vitiates the right of the first inventor to receive his pat-

ent after he has duly established the priority of his invention.

It has also been established law for many years that an applicant for patent, at any time during the prosecution of his application, is entitled to make claims commensurate with his invention, and that such claims, when made, date back to the date of filing of his application. If made in a divisional application filed while the original application is pending, they relate back to the date of filing of the original, or parent, application, and *prima facie*, the date of filing of such original application is considered the date of making of the invention.

The rule is well stated by the Circuit Court of Appeals for the Second Circuit as follows:

> "The specifications in that application for 564,586, were full enough to warrant the making of the claims here in controversy (5 and 35). At any time the application might have been amended by adding such claims, and in our opinion it is immaterial that, instead of thus amending it, he took the broader claims on another application, filed while the first was pending. The second may fairly be considered a continuation of the first, and thus Berliner's application antedates the public use, and the facts will not sustain the contention that he abandoned his invention here in suit."

(*Victor Talking Mach. Co. et al.* v. *American Graphophone Co.*, 145 Fed., 350, p. 351.)

See also:

Auto. Weighing Mchne. Co. v. *Pneu. Scale Corpn.*, 166 Fed., 288 (C. C. A., 1st Cir.).

Lemley v. *Dobson-Evans Co.*, 243 Fed., 391 (C. C. A., 6th Cir.).

Sundh Elec. Co. v. *Interborough Co.*, 198 Fed., 94 (C. C. A., 2nd Cir.).

Von Recklinghausen v. *Dempster*, 34 App. D. C., 474.

Lotz v. *Kenny*, 31 App. D. C., 205.
Dunkley v. *Beekhuis*, 39 App. D. C., 494.
Cleveland Foundry Co. v. *Detroit Vapor Stove Co.*, 131 Fed., 853, pp. 857-8 (C. C. A., 6th Cir.).

Rule 116 of the Patent Office recognizes and applies this principle as follows:

> "Rule 116. In original proceedings in cases of interference the several parties will be presumed to have made the invention in the chronological order in which they filed their completed applications for patents clearly illustrating and describing the invention; and the burden of proof will rest upon the party who shall seek to establish a different state of facts."

It also has been established law for many years that an applicant, in prosecuting his application for patent, is entitled to avail himself of the privileges allowed by the Statutes in responding to official actions by the Patent Office, and that the courts are without authority to disregard the statutory provisions in that regard. This precise question was considered by this court in the case of *U. S.* v. *Am. Bell Tel. Co.*, in which the validity of the Berliner patent was attacked on the ground that the prosecution of the application therefor had been unreasonably delayed. As it appeared in that case that the applicant had prosecuted his application in conformity with the Statutes and the Rules of the Patent Office, such objection was overruled. In the opinion, by Mr. Justice Brewer, the court says:

> "Neither can a party pursuing a strictly legal remedy be adjudged in the wrong if he acts within the time allowed and pursues the method prescribed by the statute. If the statute gives him five years within which to bring an action on a note, he cannot be denied the relief simply because he waits four years and eleven months. If he has two years after a judgment against him within which to take an ap-

peal, he may wait until the last day of the two years. Under Section 4886, Revised Statutes, an inventor has two years from the time his invention is disclosed to the public within which to make his application, and unless an abandonment is shown during that time he is entitled to a patent, and the patent runs, as any other patent, for seventeen years from its date. He cannot be deprived of this right by proof that if he had filed his application immediately after the invention the patent would have been issued two years earlier than it was, and the public therefore would have come into possession of the free use of the invention two years sooner. *The statute has given this right, and no consideration of the public benefit can take it away from him.* His right exists because Congress has declared that it should. It will not do to say that, because Congress has declared that seventeen years is the life of a patent, seventeen years is the limit of the possible monopoly; for the same legislation that gives seventeen years as the life of a patent gives two years within which an application for a patent may be made, and during that time, as well as while the application is pending in the Department, the applicant has practically, if not legally, an exclusive use. A party seeking a right under the patent statutes may avail himself of all their provisions, and *the courts may not deny him the benefit of a single one.* These are questions not of natural but of purely statutory right. Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent. *No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public.* (*U. S.* v. *Am. Bell Tel. Co. et al.*, 167 U. S., 224, p. 246.)'"*

See also:

Crown Cork & Seal Co. v. *Al. Stopper Co.*, 108 Fed., 845, p. 851 (C. C. A., 4th Cir.).

Columbia Motor Car Co. v. *Duerr & Co.*, 184 Fed., 893, p. 895 (C. C. A., 2nd Cir.).

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* Italics ours in all cases unless otherwise noted.

Nevertheless, in the case at bar the Court of Appeals, despite the fact that its attention was directed both orally and by brief to the foregoing authoritative statement of the law, deliberately ignored it and assumed the right to deny, not only to petitioners, but also to all other applicants in like case, the benefits conferred by the statutes with respect to the right of asserting and establishing priority over a rival claimant.

It has also been long-established law that abandonment of an invention is a matter for strict proof, and not of presumption.

Saunders v. *Miller,* 33 App. D. C., 456; 146 O. G., 505.

Rolfe v. *Hoffman,* 26 App. D. C., 336, p. 340; 121 O. G., 1350.

International Telephone Mfg. Co. v. *Kellogg Switchboard & Supply Co.,* 171 Fed., 651.

McDuffee v. *Hestonville M. & F. Pass. Ry. Co.,* 181 Fed., 503.

The rule announced in the Rowntree-Sloan case and in the case at bar is inconsistent with all the foregoing established rules of law, and, if valid, its enforcement will revolutionize the long-established practice of the Patent Office.

It has always been the settled policy of the patent laws of this country to reward the first inventor who has availed himself of the rights and privileges conferred by those laws to disclose his invention to the public and obtain patent protection therefor. The rule announced in the Rowntree-Sloan case, however, is not in harmony with that policy, but imposes a grievous burden upon inventors in that it requires them, especially after making application for letters patent, to critically examine the claims of each and every patent that may be issued from time to time relating to the arts in which their inventions

respectively belong, in order that if any such patent perchance contains a claim that might interfere with the invention sought to be covered by an applicant, he may introduce it into his application for purposes of interference before all right of the applicant to such claim shall have been forever lost. The fact that the Official Gazette publishes only fragmentary drawings and only a few of the claims of most patents makes this burden practically insupportable.

Until the decision in the Rowntree-Sloan case, presumptive abandonment of an *invention* was in no case predicated on inaction short of two years, and the Court of Appeals evidently overlooked the well-settled rule of law that until an application matures into a patent no presumption of abandonment arises as to any subject-matter shown and described therein but not claimed. This is manifest from the reference by the court to the Statute relating to the amendment of applications. Section 4894 provides that failure of an applicant to prosecute his application within *one* year after any action therein, of which he shall have received notice, shall work an abandonment of the *application*, but it is well settled that such failure does not work an abandonment of an *invention*, and if a statutory bar has not intervened, the applicant may file a new application and obtain a valid patent.

In the case of *Western Elec. Co.* v. *Sperry Elec. Co.*, the Circuit Court of Appeals for the Seventh Circuit, Chief Justice Fuller and Circuit Judges Woods and Jenkins sitting, stated the law as follows:

> "There is a material difference between the abandonment of an invention and the abandonment of an application for letters patent thereon by failure to comply with section 4894 of the Revised Statutes. The first gives the invention to the public, and, once done, the act is irretrievable; but, besides the power

conferred upon the commissioner of patents to relieve an applicant from an abandonment of his application under the statute, an application, which has lapsed, or been rejected or withdrawn, may be renewed or repeated so long, we suppose, as the invention itself has not been abandoned by reason of a two-years public use or otherwise."

(*Western Elec. Co.* v. *Sperry Elec. Co.*, 58 Fed., 186, p. 191.)

To the same effect is the decision of the Circuit Court of Appeals for the Eighth Circuit in the case of *Hayes-Young Tie Plate Co.* v. *St. Louis Transit Co.*

"There is a wide difference between the abandonment of an invention and the abandonment of an application for it. An abandonment of an application is not necessarily an abandonment of the invention, and, after the application has been abandonded, a valid patent for the invention may nevertheless be secured upon a new application, provided the invention has not gone into public use or been upon sale for more than two years prior to the filing of the latter. In cases in which the first application has not been abandoned, subsequent applications and amendments constitute a continuance of the original proceeding, and the two years' public use or sale which may avoid the patent must be reckoned from the presentation of the first application, and not from the filing of subsequent application or amendments. *U. S.* v. *American Bell Telephone Co.*, 167 U. S. 224, 17 Sup. Ct. 809, 42 L. Ed. 144; *Colgate* v. *Western Union Tel. Co.*, Fed. Cas. No. 2,995; *Miehle* v. *Read*, 96 O. G. 426; *Thomson-Houston Electric Co.* v. *Winchester Avenue R. Co.* (C. C.), 71 Fed. 192, 73 O. G. 2155; *Godfrey* v. *Eames*, 1 Wall. 317, 17 L. Ed. 684; *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 486, 23 L. Ed. 952; *Cain* v. *Park*, 14 App. D. C. 42, 86 O. G. 797, 798; *Ex parte Stewart*, 4 O. G. 665; *Stirling Co.* v. *St. Louis Brewing Ass'n* (C. C.), 79 Fed. 80; *Dedrick* v. *Fox* (C. C.), 56 Fed. 714, 717; *Ligowski Clay-Pigeon Co.* v. *American Clay-Bird Co.* (C. C.), 34 Fed. 328, 333."

Hayes-Young Tie Plate Co. v. *St. Louis Transit Co.*, 137 Fed., 82.

The decision of the Court of Appeals for the Second Circuit in *Kinnear Mfg. Co.* v. *Wilson* is also in point.

> "It is well settled that an inventor by describing an invention in a patent granted to him, does not preclude himself from patenting it subsequently. His omission to claim what he describes may operate as a disclaimer or an abandonment of the matter claimed; but it has no such effect when it appears that the matter thus described but not claimed was the subject of a pending application in the Patent Office by him for another patent. This was so decided by this court in *Thomson-Houston Electric Co.* v. *Elmira Railway Co.* (C. C.), 71 Fed. 396, and for other adjudications it suffices to refer to *Suffolk Co.* v. *Hayden,* 3 Wall. 315, 18 L. Ed. 76, and *Barbed Wire Case,* 143 U. S. 275, 12 Sup. Ct. 443, 36 L. Ed. 154."

Kinnear Mfg. Co. v. *Wilson,* 142 Fed., 973.

Again, applications which have been allowed and have become forfeited for failure to pay the final government fee, may be renewed at any time within two years after the allowance of the original application, and, as provided in Section 4897, upon the hearing of renewed applications, abandonment is considered *as a question of fact.* No *presumption* of abandonment arises from mere lapse of time, but must be established by proof.

In the case at bar, the Court of Appeals does not hold that the Chapman and Chapman original application was abandoned by failure to prosecute it according to law, as there is no basis for any such contention. Neither does the court hold that Chapman and Chapman specifically abandoned the subject-matter incorporated in their divisional application. It clearly could not so hold, because, as shown by the record, their divisional application was filed while their original application was still pending, and, moreover, the claims made by Chapman and Chapman in their original application directed to the bearings of the pump shaft were withdrawn in deference

to a requirement for division made by the Examiner, with a specific reservation that they would be incorporated in a divisional application. The Court of Appeals, however, goes further and holds that while the *application* was not abandoned, the *invention* which formed the subject-matter of that application was abandoned, and in support of this inconsistent position, rules that the section of the Statutes relating to abandonment of invention must be disregarded and that Section 4894 which merely relates to abandonment of applications applies.

Abandonment of an *invention* is a much more serious thing than abandonment of an *application*. The Commissioner in his opinion referred to the question of reissue merely as showing by analogy that the courts in many cases have not regarded a delay of two years in applying for a reissue as establishing abandonment of the invention not claimed in the original patent, and in the same way he referred to Section 4886, which permits an applicant to file his application within two years after a patent has been granted to another for the same invention, or after it has been published, or put into public use, and works an abandonment of *invention* after a delay of two years.

His conclusion that—

> "the diligence of one who, having already filed, copies its claims within two years of the granting of a patent, cannot be inquired into without imposing a condition more strict than is imposed by Sec. 4886 upon one who does not file his application until after the rival patent has been granted,"

is entirely sound, and shows that the rule announced by the court in the *Rowntree-Sloan* case was much more drastic than the provisions of Sec. 4886, or the rule applied in reissue cases, and therefore, should not be adhered to. The application of that rule works an aban-

donment of the *invention*—not of the *application*, and moreover, leaves the applicant no opportunity to explain or excuse his delay, which, in the case at bar, was only such delay as Section 4894 permits, and this notwithstanding the fact that where an applicant has allowed his application to become abandoned by failure to prosecute within one year, he is expressly permitted to excuse his delay, and by doing so to the satisfaction of the Commissioner, may revive his application. It is the prerogative of Congress to prescribe the rules of procedure governing applications for patents, and where Congress has spoken, the courts, it is submitted, cannot disregard the plain meaning of the statute.

The Court of Appeals is evidently desirous of expediting the prosecution of applications for patents, and what it considered to be an abuse of the privilege of amendment in the Rowntree-Sloan case was no doubt the motive which impelled it to the announcement of the ruling in that case; but, as pointed out by this court in the case of *U. S.* v. *Am. Bell Tel. Co., supra,* the views of any court as to the wisdom of a public policy instituted and approved by Congress and legally enacted are immaterial. The courts are bound to follow the law as it exists, and they have no authority to change it. In the case of *Boston Store* v. *Am. Graphophone Co. et al.*, decided by this court March 4, 1918, Mr. Chief Justice White in delivering the opinion of the court said:

> "Moreover, so far as the argument proceeds upon the assumption of the grave disaster which must come to the holders of patent-rights and articles made under them from the future application of the doctrine which the cases establish, it must be apparent that if the forebodings are real the remedy for them is to be found not in an attempt judicially to correct doctrines which by reiterated deci-

sions have become conclusively fixed, but in invoking the curative power of legislation."

Boston Store v. *Am. Graphophone Co. et al.*, 249 O. G., 985, p. 988.

The rule announced in *Rowntree* v. *Sloan*, being clearly in contravention of the Statutes, should, therefore, be disapproved and overruled.

Second Question.

On an interference appeal from the Patent Office under the Act of February 9, 1893 (27 Stat. L., 434, Ch. 74), is the jurisdiction of the Court of Appeals of the District of Columbia confined to a determination of the question of priority of invention, and may the question of whether a statutory bar exists to the grant of a patent to the actual first inventor of the subject-matter of the issue be determined on such appeal?

This precise question was answered in the negative by this court in *Lowry* v. *Allen* as follows:

> "The statute is explicit. It limits the declaration of interferences to the question of priority of invention. Section 4904 provides that in case of conflict of an application for a patent with a pending application or with an unexpired patent (as in the case at bar), the Commissioner shall give notice thereof, 'and shall direct the primary examiner to proceed to determine the question of *priority of invention*' . . . We concur with the views expressed, that the statutes provide only for appeals upon the question of priority of invention. Appeals on other questions are left to the regulation of the Patent Office under the grant of power contained in Section 483."
>
> (*Lowry* v. *Allen*, 203 U. S., 476, p. 482.)

Obviously the existence of a statutory bar has nothing to do with the question of priority, and the Court of Appeals has itself repeatedly so held. See:

Norling v. *Hayes,* 37 App. D. C., 169 (pp. 177, 178), and cases therein cited.

Slingluff v. *Sweet & Spinasse,* 45 App. D. C., —; 230 O. G., 659.

Frost v. *Chase,* 37 App. D. C., 179.

The Court of Appeals, however, attempts to distinguish the present case from one involving a statutory bar on the ground that a question of laches and not one of a statutory bar is here involved. The court, as is apparent from the cases cited in the opinion, failed to appreciate the distinction between laches in completing an invention, and abandonment of a completed invention. Chapman and Chapman having reduced their invention to practice by filing their application for patent before Wintroath conceived the invention, laches could not enter into the question of priority as between the parties. Indeed, there could be no question of priority between them. The only question was whether or not Chapman and Chapman had abandoned the invention to the public. They certainly could not abandon it to Wintroath because he could not qualify under the Statute as the first inventor. If Chapman and Chapman had not abandoned the invention they were entitled to their patent, regardless of Wintroath's patent, and Wintroath does not enter into that question at all.

The decision of the Court of Appeals, therefore, in effect holds that that court has jurisdiction to consider the question of the statutory bar of abandonment on an interference appeal, notwithstanding the ruling to the contrary of this court in *Lowry* v. *Allen, supra.*

In *Bate Refrigerating Co.* v. *Sulzberger,* this court said:

"If Section 4887 of the Revised Statutes is so worded as to express clearly the intention of Con-

gress, the court must give effect to that intention. But even if the statute be not so explicit as to preclude construction; if upon applying to it the established rules of interpretation; if looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting either one of two constructions; this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the government, and with the course of judicial decisions in the Circuit Courts of the United States; especially, if there be reason to suppose that vast interests may have grown up under that practice and under judicial decisions, which may be disturbed or destroyed by the announcement of a different rule."

Bate Refrigerating Co. v. *Sulzberger*, 157 U. S., 1, page 34.

The foregoing remarks apply specifically to the case at bar. The fact that the Patent Office and the courts have for more than forty years harmoniously interpreted and applied the Statutes bearing upon the facts of this case is sufficient ground for assuming that the practice so established is sound and should not be overturned. But the Court of Appeals of the District of Columbia has now taken a different and novel view of the law, and the authoritative relation sustained by that court to the Patent Office makes it of vital importance that this court consider the questions involved and finally determine the correct practice. It is, therefore, respectfully submitted that the writ prayed for should be granted.

Respectfully submitted,

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